

domestic representative of record, if one has been appointed, at the correspondence address of record in the Office, and the required fee, unless the notice is filed in accordance with § 2.198.

[68 FR 55765, Sept. 26, 2003, as amended at 72 FR 42258, Aug. 1, 2007; 73 FR 47685, Aug. 14, 2008]

#### **§ 2.102 Extension of time for filing an opposition.**

(a) Any person who believes that he, she or it would be damaged by the registration of a mark on the Principal Register may file in the Office a written request, addressed to the Trademark Trial and Appeal Board, to extend the time for filing an opposition. The written request need not be verified, but must be signed by the potential opposer or by the potential opposer's attorney, as specified in § 11.1 of this chapter, or authorized representative, as specified in § 11.14(b) of this chapter. Electronic signatures pursuant to § 2.193(c)(1)(iii) are required for electronically filed extension requests.

(1) A written request to extend the time for filing an opposition to an application filed under section 1 or 44 of the Act must be filed either on paper or through ESTTA.

(2) A written request to extend the time for filing an opposition to an application filed under section 66(a) of the Act must be filed through ESTTA.

(b) A written request to extend the time for filing an opposition must identify the potential opposer with reasonable certainty. Any opposition filed during an extension of time should be in the name of the person to whom the extension was granted. An opposition may be accepted if the person in whose name the extension was requested was misidentified through mistake or if the opposition is filed in the name of a person in privity with the person who requested and was granted the extension of time.

(c) The time for filing an opposition shall not be extended beyond 180 days from the date of publication. Any request to extend the time for filing an opposition must be filed before thirty days have expired from the date of publication or before the expiration of a previously granted extension of time,

as appropriate. Requests to extend the time for filing an opposition must be filed as follows:

(1) A person may file a first request for either a thirty-day extension of time, which will be granted upon request, or a ninety-day extension of time, which will be granted only for good cause shown.

(2) If a person was granted a thirty-day extension of time, that person may file a request for an additional sixty-day extension of time, which will be granted only for good cause shown.

(3) After receiving one or two extensions of time totaling ninety days, a person may file one final request for an extension of time for an additional sixty days. The Board will grant this request only upon written consent or stipulation signed by the applicant or its authorized representative, or a written request by the potential opposer or its authorized representative stating that the applicant or its authorized representative has consented to the request, or a showing of extraordinary circumstances. No further extensions of time to file an opposition will be granted under any circumstances.

[68 FR 55765, Sept. 26, 2003, as amended at 73 FR 47685, Aug. 14, 2008]

#### **§ 2.104 Contents of opposition.**

(a) The opposition must set forth a short and plain statement showing why the opposer believes he, she or it would be damaged by the registration of the opposed mark and state the grounds for opposition.

(b) Oppositions to different applications owned by the same party may be joined in a consolidated opposition when appropriate, but the required fee must be included for each party joined as opposer for each class in which registration is opposed in each application against which the opposition is filed.

[54 FR 34897, Aug. 22, 1989, as amended at 68 FR 55766, Sept. 26, 2003]

#### **§ 2.105 Notification to parties of opposition proceeding(s).**

(a) When an opposition in proper form (see §§ 2.101 and 2.104), with proof of service in accordance with § 2.101(b), has been filed and the correct fee has

## § 2.106

been submitted, the Trademark Trial and Appeal Board shall prepare a notification, which shall identify the title and number of the proceeding and the application involved and shall designate a time, not less than thirty days from the mailing date of the notification, within which an answer must be filed. If a party has provided the Office with an e-mail address, the notification may be transmitted via e-mail.

(b) The Board shall forward a copy of the notification to opposer, as follows:

(1) If the opposition is transmitted by an attorney, or a written power of attorney is filed, the Board will send the notification to the attorney transmitting the opposition or to the attorney designated in the power of attorney, provided that the person is an "attorney" as defined in § 11.1 of this chapter.

(2) If opposer is not represented by an attorney in the opposition, but opposer has appointed a domestic representative, the Board will send the notification to the domestic representative, unless opposer designates in writing another correspondence address.

(3) If opposer is not represented by an attorney in the opposition, and no domestic representative has been appointed, the Board will send the notification directly to opposer, unless opposer designates in writing another correspondence address.

(c) The Board shall forward a copy of the notification to applicant, as follows:

(1) If the opposed application contains a clear indication that the application is being prosecuted by an attorney, as defined in § 11.1 of this chapter, the Board shall send the documents described in this section to applicant's attorney.

(2) If the opposed application is not being prosecuted by an attorney but a domestic representative has been appointed, the Board will send the documents described in this section to the domestic representative, unless applicant designates in writing another correspondence address.

(3) If the opposed application is not being prosecuted by an attorney, and no domestic representative has been appointed, the Board will send the documents described in this section directly to applicant, unless applicant

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designates in writing another correspondence address.

[68 FR 55766, Sept. 26, 2003, as amended at 72 FR 42258, Aug. 1, 2007; 73 FR 47685, Aug. 14, 2008]

### § 2.106 Answer.

(a) If no answer is filed within the time set, the opposition may be decided as in case of default.

(b)(1) An answer shall state in short and plain terms the applicant's defenses to each claim asserted and shall admit or deny the averments upon which the opposer relies. If the applicant is without knowledge or information sufficient to form a belief as to the truth of an averment, applicant shall so state and this will have the effect of a denial. Denials may take any of the forms specified in Rule 8(b) of the Federal Rules of Civil Procedure. An answer may contain any defense, including the affirmative defenses of unclean hands, laches, estoppel, acquiescence, fraud, mistake, prior judgment, or any other matter constituting an avoidance or affirmative defense. When pleading special matters, the Federal Rules of Civil Procedure shall be followed. A reply to an affirmative defense need not be filed. When a defense attacks the validity of a registration pleaded in the opposition, paragraph (b)(2) of this section shall govern. A pleaded registration is a registration identified by number and date of issuance in an original notice of opposition or in any amendment thereto made under Rule 15, Federal Rules of Civil Procedure.

(2)(i) A defense attacking the validity of any one or more of the registrations pleaded in the opposition shall be a compulsory counterclaim if grounds for such counterclaim exist at the time when the answer is filed. If grounds for a counterclaim are known to the applicant when the answer to the opposition is filed, the counterclaim shall be pleaded with or as part of the answer. If grounds for a counterclaim are learned during the course of the opposition proceeding, the counterclaim shall be pleaded promptly after the grounds therefor are learned. A counterclaim need not be filed if it is the subject of another proceeding between the same parties or anyone in privity therewith.